**UNITED STATES DEPARTMENT OF COMMERCE**
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 09/400,607 | 09/20/99 | CASWELL T | 400.081US2 |

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| EXAMINER | |
|---|---|
| TON, D | |
| **ART UNIT** | **PAPER NUMBER** |
| 2732 | 7 |

**DATE MAILED:** 08/28/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

| Application No. | Applicant(s) |
|---|---|
| 09/402,607 | Caswell et al |
| **Examiner** | **Group Art Unit** |
| DANG TRAN | 2732 |

***—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—***

**Period for Response**

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

☒ Responsive to communication(s) filed on 9/20/99.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

**Disposition of Claims**

☒ Claim(s) 7-19 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☐ Claim(s)_____ is/are allowed.

☒ Claim(s) 7-19 is/are rejected.

☐ Claim(s)_____ is/are objected to.

☐ Claim(s)_____ are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on_____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

**Attachment(s)**

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☒ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948 Substitute

☐ Other_____

**Office Action Summary**

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-13 and 16-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Long (5,377,260).

Long discloses a telephone circuit to control off-hook status during receipt of called ID signal comprising:

preprogramming method device with access parameters;

detecting a phone call;

receiving caller identification information without answering the phone call;

decoding caller identification information;

comparing caller identification information with access parameters to determine whether access is authorized;

if access is unauthorized, hanging up; and

if access is authorized, enabling a connection to the telephone personal communications system (see details of figure 3B).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Long.

Long discloses all the subject matter of the claimed invention with the exception of a list of unauthorized caller names in a communications network. However, using the list of the unauthorized caller names in the Long does not provide any unexpected results. Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the list of unauthorized users names in the communications network of Long for the purpose of security reason.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ 2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 7-15 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 5,546,448. Although the conflicting claims are not identical, they are not patentably distinct from each other because the applicant's claims 7-15 and 19 merely broaden the scope of patent number 5,546,448 claims 1-13 by eliminating some features. The omission

of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

6. Claims 7-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7, line 10, "if access is unauthorized, hanging up" is not clear because applicant previously mention receiving caller identification information without answering the phone call. How can it hang up when it does not pick up the phone.

Claims 8-15 are rejected since they depend from claim 7.

In claim 16, "the internal personal communication system interface" has no antecedent basis. The same is true with the terms "the internal personal communications system interface" and "the interface" recite in claim 19.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Caswell et al. (6,009,082) and Shazma et al. (5,452,289) are all cited to show

caller ID systems which are considered to be pertinent to the claimed invention.

8. Any inquiry concerning this communication should be directed to Dang Ton at telephone number (703) 305-4739.

DT/ayc

August 15, 2000

DANG TON
PRIMARY EXAMINER